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Date of Deposit or Transmission: Aug. 8, 2002 Signature: Kalyn Black

Typed or Printed Name: Kalyn Black

### IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In Re Application of: )  
TEDDY C. JOHNSON )  
Serial No.: 09/092,488 ) Group Art Unit 2161  
Filed: June 5, 1998 ) Examiner: Hyung Sub Sough  
For: HIGH PERFORMANCE ) Attorney Docket 10980822-1  
SERVER DATA DELIVERY )  
SYSTEM AND METHOD )

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### APPELLANT'S REPLY BRIEF IN RESPONSE TO EXAMINER'S ANSWER MAILED ON JUNE 17, 2002

BOX AF

Assistant Commissioner for Patents  
Washington, D.C. 20231

Dear Sir:

In response to the Examiner's Answer mailed on June 17, 2002, the Appellant replies as follows.

### **Argument**

The Appellant respectfully disagrees with the arguments made in the Examiner's Answer.

It should be noted that the Examiner's Answer is, for the most part, a reiteration of the final rejection. Accordingly, most of the issues raised in the Examiner's Answer were addressed in the Appellant's Appeal Brief. The following is a brief summary of these issues.

#### **NO MOTIVATION TO COMBINE**

During prosecution and in the Appeal Brief, the Appellant alleged that there is no motivation for the Examiner to combine the references of Joffe and Kawaguchi.

In response to the lack of motivation to combine issue, the Examiner's Answer states at the first full paragraph of page 7 that:

However, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious.

The Appellant respectfully notes that no advantages have been recognized by the Appellant which would flow from the prior art. As stated in the Appeal Brief, the Appellant does not understand how the references could be combined to yield the Appellant's invention. In addition, even if the references could be combined, their combination is missing many of the claimed elements. These missing claimed elements are described in detail in the Appeal Brief.

Accordingly, the Appellant respectfully contends that there is no motivation to combine the cited references.

On page 8 of the Examiner's Answer, the "objective reasons for the combination" are set forth. These "objective reasons" are replicated as follows for convenience:

...to solve "The problems of latency and bandwidth constraints" (see column 1, lines 51-53 of Joffe) and to provide a filing storage system (i.e., a file management system) that improves disk space efficiency, simplifies file management, and incorporates data to access stored objects (column 1, liens 51-53 of Kawaguchi).

The Examiner has not shown that the teachings of the references would lead an individual to combine the references. More specifically, Joffe is directed toward latency and bandwidth constraints and Kawaguchi is directed toward an improvement of a file management system. Neither reference suggests the elements of Appellant's claim 1, which include facilitating the transfer of data to authorized users over the Internet.

Accordingly, the Appellant contends that there is no motivation to combine the references.

#### **COMBINATION DOES NOT DISCLOSE ALL THE ELEMENTS OF CLAIM 1**

The Appellant contends that even if the combination of the references is proper, the combination does not disclose all the claimed elements. The Examiner's Answer indicates that several of the missing elements as well-known or obvious. The Appellant respectfully disagrees with the Examiner.

In rebutting the Appellant's contention that all the claimed elements are not disclosed, page 9 of the Examiner's Answer states:

...the rejections are based on combinations of references and one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.

The Appellant respectfully notes that the combination of the references does not disclose all the elements of claim 1. Accordingly, the Appellant "attacked" the combination of the references in the rebuttals to the office actions and the "attacks" are described in detail in the Appeal Brief.

As stated above, the combination does not disclose all the elements of the claims. For example, the Appellant noted six elements of the claims that were not disclosed by the combination. The Examiner held that these missing elements were, in summary, well-known. The Appellant contends that these missing elements are not well-known, especially when there is not motivation to combine the references.

Between the bottom of page 8 and the middle of page 9 of the Examiner's Answer, the Examiner's Answer bases obviousness on legal decisions. The Appellant still does not understand the significance of this argument. None of the cases cited during prosecution provide a legal decision based on the Appellant's subject matter. Therefore, use of section 2144 of the MPEP as used in the Examiner's Answer is irrelevant.

The Appellant contends that all of the pending claims are allowable and all of the rejections should be reversed.

Respectfully submitted,

KLAAS, LAW, O'MEARA & MALKIN, P.C.

August 8, 2002

By:

  
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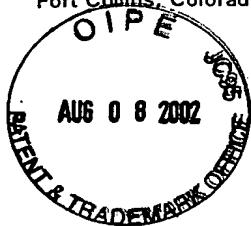
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PATENT APPLICATION

ATTORNEY DOCKET NO. 10980822-1



IN THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Teddy C. Johnson

Confirmation No.: 6145

Application No.: 09/092,488

Examiner: Hyung Sub Sough

Filing Date: June 5, 1998

Group Art Unit: 2161

Title: HIGH PERFORMANCE SERVER DATA DELIVERY SYSTEM AND METHOD

COMMISSIONER FOR PATENTS  
Washington, D.C. 20231

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AUG 15 2002  
GROUP 3600

Sir:

TRANSMITTAL OF REPLY BRIEF

Transmitted herewith in *triplicate* is the Reply Brief with respect to the Examiner's Answer mailed on Aug. 8, 2002. This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new grounds of rejection.)

No fee is required for filing of this Reply Brief.

If any fees are required please charge Deposit Account 08-2025.

(X) I hereby certify that this correspondence is being deposited with the United States Postal Service as express mail in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231. Date of Deposit: Aug. 8, 2002

Respectfully submitted,

Teddy C. Johnson

By RW

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Date: Aug. 8, 2002

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